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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,828	06/11/1999	WALTER GUENTER	GUENTER-1(P)	3616

7590

11/04/2003

COLLARD & ROE
1077 NORTHERN BOULEVARD
ROSLYN, NY 115761696

EXAMINER

AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 11/04/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

C10-25

Office Action Summary	Application No.	Applicant(s)	
	09/319,828	GUENTER, WALTER	
	Examiner	Art Unit	
	Sheeba Ahmed	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 19, 20, 22 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 15, 19, 20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendments to claims 15, 19, and 15 have been entered in the above-identified application. Claims 1-1, 16-18, 21, and 23-31 have been cancelled. New claim 32 has been added. **Claims 15, 19, 20, 22, and 32 are now pending.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 15, 19, 20, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkie (US 5,981,047).

Wilkie discloses a co-extruded polyolefin packaging film comprising a core layer having a cold seal release layer (*corresponding to the plastic film of the claimed invention*) formed thereon (Column 3, lines 47-51). The release layer composition comprises polybutylene, a second polymeric blend, and non-migratory slip agent (*corresponding to the materials having release properties towards adhesives and meeting the limitation that such materials do not diffuse into an adhesive when the plastic film is disposed next to an adhesive*) in an amount sufficient to decrease the coefficient of friction of the release layer (*indicating that the slip agent in*

Art Unit: 1773

embedded in the polymeric materials and thus meeting the limitations of claim

19). Examples of such non-migratory slip agents include cross-linked silicone particles

(corresponding to the silicone compound of the claimed invention as recited in

claim 15) and various inorganics such as talc, silica, glass beads and clay

(corresponding to the inorganic fillers of the claimed invention as recited in claim

20) (Column 5, lines 25-31, lines 56-67 and Column 6, lines 1-3). A matte-finish film

surface can be obtained by embossing (Column 2, lines 54-58). In light of the

Specification and the explanation provided by the Applicants on Page 5 of the

Response submitted on January 30, 2002, the Examiner has interpreted the term "self-

carrying" to mean a film that can be extruded together with additional layers and since

the cold seal release film disclosed by Wilkie can be co-extruded, the Examiner takes

the position that the cold seal release layer disclosed by Wilkie meets the "self-carrying"

limitation. All limitations of claims 15, 19, 20, and 32 are disclosed in the above

reference.

3. Claims 15 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Higgins (US 5,932,352).

Higgins discloses a release film comprising a polymeric film substrate and a release layer ***(corresponding to the plastic film of the claimed invention)*** formed from a silicone resin ***(corresponding to the material having release properties towards adhesives and meeting the limitations that such a material is a silicone compound and does not diffuse into an adhesive when the plastic film is***

Art Unit: 1773

disposed next to an adhesive) and a curable polymer (Column 1, lines 57-61). The silicone resin may be a polysiloxane (Column 4, lines 35-37). The release film may vary in thickness depending on the application and may be in the range of 5 to 350 microns ***(thus meeting the limitation of claim 22)*** (Column 8, lines 43-48). In light of the Specification and the explanation provided by the Applicants on Page 5 of the Response submitted on January 30, 2002, the Examiner has interpreted the term "self-carrying" to mean a film that can be extruded together with additional layers and since the release film disclosed by Higgins could be co-extruded, the Examiner takes the position that the release film disclosed by Higgins meets the "self-carrying" limitation. Furthermore, the Examiner interprets the limitation that the material having release properties is extruded together with the plastic film to be a process limitation and the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the plastic film) is the same despite the process limitations of extruding given that the material having release properties is bound within the film. All limitations of claims 15 and 22 are disclosed in the above reference.

Response to Arguments

4. Applicant's arguments filed on August 15, 2003 (Paper No. 24) have been fully considered but they are not persuasive.

Applicants traverse the rejections based on Wilkie (US 5,981,047) and Higgins (US 5,932,352) and submit that Wilkie and Higgins are constructed of several layers and the release layer has no mechanical firmness in the sense of a self-carrying film. However, as pointed out above, the Examiner has interpreted the term "self-carrying" in light of the Specification and the explanation provided by the Applicants on Page 5 of the Response submitted on January 30, 2002 to mean a film that can be extruded together with additional layers and since the release film disclosed by Wilkie and Higgins could be co-extruded, the Examiner takes the position that the release film disclosed by Wilkie and Higgins meets the "self-carrying" limitation.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

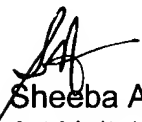
Art Unit: 1773

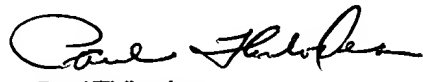
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-0594. The examiner can normally be reached on Mondays and Thursdays from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5665.


Sheeba Ahmed
Art Unit 1773
October 30, 2003


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700